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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205697
Party	Defendant Barron, Ellington
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Cheeseburger Restaurants, Inc and
Cheeseburger in Paradise, Inc.
Opposer,

v.

Ellington Barron

Applicant

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Serial No. – 85/499,539

Opposition No. 91205697

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Ellington Barron, hereby, answers the Notice of Opposition filed in the matter by Cheeseburger Restaurants, Inc and Cheeseburger in Paradise, Inc. as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 1 of the Notice of Opposition and the preceding background supplied by Opposer, and on that basis denies such allegations.
2. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 2 of the Notice of Opposition, and on that basis denies such allegations.
3. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 3 of the Notice of Opposition, and on that basis denies such allegations.
4. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 4 of the Notice of Opposition, and on that basis denies such allegations.
5. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 5 of the Notice of Opposition, and on that basis denies such allegations.

6. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 6 of the Notice of Opposition, and on that basis denies such allegations.
7. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 7 of the Notice of Opposition, and on that basis denies such allegations.
8. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 8 of the Notice of Opposition, and on that basis denies such allegations. Additionally upon information and belief, Applicant asserts that Opposer's '610, '754, and '057 registrations are subject to concurrent use limitations and are limited to the area comprising Hawaii pursuant to a decree from the US District Court for the Central District of California (Civil Action CV-98-1730 CM (AIJx))
9. Denied. Applicant lacks knowledge or information sufficient to form a belief as to the allegations related to whether the CHEESE BURGER marks are registered, used, or abandoned and on that basis, denies Opposer's allegations related to those matters. Applicant denies the Opposer's allegations that the marks are substantially similar or related in the nature of goods & services.

Applicant also denies Opposer's allegations that Applicant's mark poses any likelihood of confusion, mistake, or deception under Section 2d of the Act, in relation to the CHEESE BURGER marks on several grounds, including but not limited to:

(a) Applicant's mark is a strong and distinctive mark, such that no conflicting marks were found by the trademark examiner.

(b) Applicant's mark is sufficiently different in its entirety to Opposer's mark as to appearance, sound, connotation, and/or commercial impression so as to preclude any likelihood of confusion, as illustrated by the following:

- (i) All of the Opposer's cited registrations contain the term "cheese burger" and it appears that Opposer produces, sells, or serves cheese burgers. Applicant's mark does not contain the term "cheese burger" and Applicant does not produce, sell, or serve cheese burgers or food.
- (ii) Applicant's mark contains the words "House of Paradise Collection" displayed in a words/design mark in International Class 025. Although two of Opposer's cited registrations have the word Paradise, none of the Opposer's cited marks contain the words "House of." None of the Opposer's cited registrations contain the word "Collection."

- (iii) Applicant's mark contains the word "paradise" and Applicant's mark is in International class 025 with goods/services description listed as "hat, jackets, jeans, scarves, shoes, sweaters, t-shirts, and wrist bands.

The only cited marks of Opposer that contain the word "paradise" are the '610, '754, and '057 registrations and these registrations are in International Class 042 with goods/services descriptions listed as "restaurant and bar services." Also the '610, '754, and '057 registrations are limited to the area comprising Hawaii pursuant to a decree of the US District Court for the Central District of California in Civil Action CV 98-1730 CM (AIJx).

- (iv.) The palm tree displayed in the Applicant's mark has a significantly different appearance than any palm tree displayed in Opposer's cited registrations. If one is viewing the Applicant's mark, the palm tree is leaning toward the viewer's right side and the palm tree has four large leaves. The palm tree in the Applicant's mark is standing on a mound of sand and there is a sign that displays the text "H.O.P" in the sand.

If one is viewing the palm tree in any of the Opposer's cited registrations, the palm tree in the Opposer's marks is leaning the viewer's left side and has six leaves emanating from the tree. There is no sand at the base of the tree and there is no sign with the text "H.O.P" in the sand near the Opposer's tree.

- (v.) In the Opposer's cited registrations that contain a palm tree, there is a picture of the sun as part of the mark. There is no picture of the sun in Applicant's mark.

- (vi.) Applicant's mark has a thick ring with the stylized text along the top and bottom of the thick ring. In Applicant's mark, there is stylized text across the entire thick ring. Applicant's mark does not have entire words lying outside of the thick ring and Applicant's entire mark is surrounded by a double lined border.

Opposer's registrations do not have a thick ring and do not have stylized text across such ring. Opposer's cited registrations do not have a double lined border surrounding the mark.

In fact, the Opposer's cited '966, '196, '057, '903 registrations have a thin ring around the palm tree and there is no stylized text across the thin ring. Additionally, Opposer's '966, '196, '057, '903 registrations have entire words clearly outside the boundaries of the thin ring and have no words inside the boundaries of the thin ring. As stated previously, none of the Opposer's registrations have a double lined border surrounding the mark.

Opposer's '610 and '754 marks have words alone without a design.

(c) Goods to be sold by the Applicant are sufficiently different from those sold by Opposer so as to preclude any likelihood of confusion.

Applicant's mark is in International class 025 with goods/services description listed as "hat, jackets, jeans, scarves, shoes, sweaters, t-shirts, and wrist bands.

Applicant has a bona fide intent to use Applicant's mark in commerce on all goods listed in the goods and services description of Applicant's trademark application and/or Applicant has already used the mark in commerce after the filing date of Applicant's trademark application.

Although the Opposer's registration '966 is in International Class 25, all of the other registrations cited by the Opposer are in International Class 21 or International class 42.

The Opposer's '196 registration is in International class 021 with a goods/services description listed as "beverage, glass ware, and mugs."

Opposer's '610, 057, '754 , '903 registrations are in Class 42 with a goods/service description listed as "restaurant and bar services"

(d) The consumer markets and trade channels through which Applicant shall sell Applicant's goods are sufficiently different from those of the Opposer so as to preclude any likelihood of confusion.

In particular, Opposer's '610, '057, '754 registrations are limited to the area comprising Hawaii, pursuant to a decree of the US District Court for the Central District of California, Western Division in Civil Action No. CV-98-1730 CM (AIJx)

(e) The conditions under which Applicant will sell Applicant's goods are sufficiently different from those under which Opposer's goods are sold so as to preclude any likelihood of confusion.

Applicant reserves the right to amend this answer to plead more facts to establish that Applicant's mark is not substantially similar or related in the nature of goods & services compared to the Opposer's marks.

10. Denied. Applicant's use of the Applicant's mark in nationwide commerce will not conflict with Opposer's rights. Applicant alleges, upon information and belief, that Opposer doesn't have the exclusive right to use all of the cited registrations nationwide. In particular, Opposer's '610, 057, '754 registrations are limited to the area comprising Hawaii, pursuant to a decree of the US District Court for the Central District of California, Western Division in Civil Action No. CV-98-1730 CM (AIJx).

Additionally, Applicant has found Registration 3137799 and Registration 3137801 for marks containing the term "Cheese Burger In Paradise" and

containing palm trees in International Class 025. The registrations 3137799 and 3137801 were registered by Jimmy Buffett and are currently owned by JB Intellectual Property, LLC. This implies that the Opposer does not have the exclusive right to use marks containing the terms "Cheeseburger in Paradise" and that there are limitations to the Opposer's '610, '057, and '754 registrations.

11. Denied. Applicant lacks knowledge or information sufficient to form a belief as to the allegations of advertising, promotion, long use, or non-abandonment in Paragraph 11 of the Notice of Opposition and on that basis denies such allegations.

Applicant also lacks knowledge or information concerning whether the public has come to associate Opposer with the CHEESE BURGER marks. More specifically, Opposer did not plead and/or provide facts to prove that the CHEESE BURGER marks are famous.

Applicant asserts that Opposer's CHEESE BURGER marks are not famous. Opposer failed to plead or provide facts to prove that the CHEESE BURGER marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the CHEESE BURGER name and marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the CHEESE BURGER name and marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use.

Lastly, Opposer has failed to plead specific facts to prove that the Opposer's name and marks have been adjudicated as famous by a court of competent jurisdiction in the United States.

12. Denied. Applicant lacks knowledge or information sufficient to form a belief as to the allegations of widespread use, continuous use, registrations, statutory rights, or common law rights in Paragraph 12 of the Notice of Opposition and on that basis denies such allegations.
13. Denied. Applicant lacks knowledge or information sufficient to form a belief as to the allegations of Opposer's statutory rights or common law rights in Paragraph 13 of the Notice of Opposition and on that basis denies such allegations. Applicant denies Opposer's alleged claim that Applicant is not entitled to register Applicant's mark pursuant to Section 2(d) of the Lanham Act, 15 USC § 1052 (d).
14. Denied. Applicant denies that Applicant's mark dilutes, will dilute, or is likely to dilute the CHEESE BURGER marks. Applicant denies all other allegations in Paragraph 14 of the Notice of Opposition.

By claiming trademark dilution, Opposer implicitly asserts that Opposer's CHEESE BURGER marks are famous. Applicant expressly denies that the CHEESE BURGER marks are famous.

Opposer failed to plead and provide specific facts to support any claim that the CHEESE BURGER marks have become famous. Opposer did not plead and/or provide facts to prove that the CHEESE BURGER marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the CHEESE BURGER marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the CHEESE BURGER marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys, and details regarding length of use.

Additionally, Opposer has failed to plead specific facts to prove that the CHEESE BURGER marks have been adjudicated as famous by a court of competent jurisdiction in the United States.

Moreover, Opposer has failed to plead specific facts to prove all elements of dilution by blurring. Opposer has failed to plead or provide specific facts to prove that Applicant's mark weakens the power of the CHEESE BURGER marks through identification with dissimilar goods.

More specifically, Opposer has not pleaded specific facts to prove dilution by blurring via examination of the following traditional factors:

- (i) the degree of similarity between the mark or trade name and the famous mark,
- (ii) the degree of inherent or acquired distinctiveness,
- (iii) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark,
- (iv) degree of recognition of the famous mark,
- (v) whether the user of the alleged infringing mark or trade name intended to create an association with the famous mark, and
- (vi) any actual association between the mark or trade name and the famous mark.

Additionally, Opposer has failed to plead specific facts to prove dilution by tarnishment. More specifically, Opposer has failed to plead or provide specific facts to prove that Applicant's mark casts the CHEESE BURGER marks in an unflattering light or harms the reputation of the CHEESE BURGER marks through association with inferior products or services.

15. Denied. Applicant lacks knowledge or information sufficient to form a belief as to the allegations that Opposer will be damaged by registration of Applicant's mark in Paragraph 15 of the Notice of Opposition and on that basis denies such allegations. Applicant denies Opposer's allegation that registration of Applicant's mark would violate Opposer's trademark and trade name rights.

AFFIRMATIVE DEFENSES

Without admitting or acknowledging that Ellington Barron bears any burden of proof as to any of the defenses listed below, Ellington Barron asserts the following defenses.

First Affirmative Defense (Lack of Standing)

Opposer has not demonstrated sufficient standing, in that Opposer has not pleaded or provided specific details and/or written evidence to support a reasonable basis for a belief that the Opposer will be damaged by registration of the Applicant's mark.

Second Affirmative Defense (No likelihood of Confusion)

There is no likelihood of confusion and the marks are not confusingly similar. Applicant makes the following assertions to disprove likelihood of confusion:

- (a) Applicant's mark is a strong and distinctive mark, such that no conflicting marks were found by the trademark examiner. Applicant has a bona fide intent to use Applicant's mark in commerce on all goods listed in the goods and services description of Applicant's trademark application and/or Applicant has already used the mark in commerce after the filing date of Applicant's trademark application.
- (b) Applicant's mark is sufficiently different in its entirety to Opposer's mark as to appearance, sound, connotation, and/or commercial impression so as to preclude any likelihood of confusion, as illustrated by the following:
 - (i) All of the Opposer's cited registrations contain the term "cheese burger" and it appears that Opposer produces, sells, or serves cheese burgers. Applicant's mark does not contain the term "cheese burger" and Applicant does not produce, sell, or serve cheese burgers or food.
 - (ii) Applicant's mark contains the words "House of Paradise Collection" displayed in a words/design mark in International Class 025. Although two of Opposer's cited registrations have the word "paradise", none of the Opposer's cited marks contain the words "House of." None of the Opposer's cited registrations contain the word "Collection."

- (iii) Applicant's mark contains the word "paradise" and Applicant's mark is in International class 025 with goods/services description listed as "hat, jackets, jeans, scarves, shoes, sweaters, t-shirts, and wrist bands.

The only cited marks of Opposer that contain the word "paradise" are the '610, '754, and '057 registrations and these registrations are in International Class 042 with goods/services descriptions listed as "restaurant and bar services." Also the '610, '754, and '057 registrations are limited to the area comprising Hawaii pursuant to a decree of the US District Court for the Central District of California in Civil Action CV 98-1730 CM (AlJx).

- (iv) The palm tree displayed in the Applicant's mark has a significantly different appearance than any palm tree displayed in Opposer's cited registrations. If one is viewing the Applicant's mark, the palm tree is leaning toward the viewer's right side and the palm tree has four large leaves. The palm tree in the Applicant's mark is standing on a mound of sand and there is a sign that displays the text "H.O.P" in the sand.

If one is viewing the palm tree in any of the Opposer's cited registrations, the palm tree in the Opposer's marks is leaning the viewer's left side and has six leaves emanating from the tree. There is no sand at the base of the tree and there is no sign with the text "H.O.P" in the sand near the Opposer's tree.

- (v) In the Opposer's cited registrations that contain a palm tree, there is a picture of the sun as part of the mark. There is no picture of the sun in Applicant's mark.

- (vi) Applicant's mark has a thick ring with the stylized text along the top and bottom of the thick ring. In Applicant's mark, there is stylized text across the entire thick ring. Applicant's mark does not have entire words lying outside of the thick ring and Applicant's entire mark is surrounded by a double lined border.

Opposer's registrations do not have a thick ring and do not have stylized text across such ring. Opposer's cited registrations do not have a double lined border surrounding the mark.

In fact, the Opposer's cited '966, '196, '057, '903 registrations have a thin ring around the palm tree and there is no stylized text across the thin ring. Additionally, Opposer's '966, '196, '057, '903 registrations have entire words clearly outside the boundaries of the thin ring and have no words inside the boundaries of the thin ring. As stated previously, none of the Opposer's registrations have a double lined border surrounding the mark.

Opposer's '610 and '754 marks have words alone without a design.

(c) Goods to be sold by the Applicant are sufficiently different from those sold by Opposer so as to preclude any likelihood of confusion.

Applicant's mark is in International class 025 with goods/services description listed as "hat, jackets, jeans, scarves, shoes, sweaters, t-shirts, and wrist bands.

Although the Opposer's registration '966 is in International Class 25, all of the other registrations cited by the Opposer are in International Class 21 or International class 42.

The Opposer's '196 registration is in International class 021 with a goods/services description listed as "beverage, glass ware, and mugs."

Opposer's '610, 057, '754 , '903 registrations are in Class 42 with a goods/service description listed as "restaurant and bar services"

(d) The consumer markets and trade channels through which Applicant shall sell Applicant's goods are sufficiently different from those of the Opposer so as to preclude any likelihood of confusion.

In particular, Opposer's '610, 057, '754 registrations are limited to the area comprising Hawaii, pursuant to a decree of the US District Court for the Central District of California, Western Division in Civil Action No. CV-98-1730 CM (AIJx)

(e) The conditions under which Applicant will sell Applicant's goods are sufficiently different from those under which Opposer's goods are sold so as to preclude any likelihood of confusion.

Applicant reserves the right to amend this answer to plead more facts to establish that Applicant's mark is not substantially similar or related in the nature of goods & services compared to the Opposer's marks.

Third Affirmative Defense (No Likelihood Dilution and No Actual Dilution)

There is no likelihood of dilution and there is no actual dilution. Applicant makes the following assertions to disprove likelihood of dilution and/or actual dilution:

Opposer failed to plead and provide specific facts to support any claim that the CHEESE BURGER marks have become famous. Opposer did not plead and/or provide facts to prove that the CHEESE BURGER marks are famous to customers or to potential customers in the relevant market. Opposer also failed to plead and/or provide specific facts to prove that the CHEESE BURGER marks have widespread renown and recognition by general public.

Opposer also failed to plead specific facts and/or provide detailed evidence to establish fame of the CHEESE BURGER marks, such as detailed advertising figures, detailed sales figures, market share analyses, brand recognition surveys,

and details regarding length of use.

Additionally, Opposer has failed to plead specific facts to prove that the CHEESE BURGER marks have been adjudicated as famous by a court of competent jurisdiction in the United States.

Moreover, Opposer has failed to plead specific facts to prove all elements of dilution by blurring. Opposer has failed to plead or provide specific facts to prove that Applicant's mark weakens the power of the CHEESE BURGER marks through identification with dissimilar goods.

More specifically, Opposer has not pleaded specific facts to prove dilution by blurring via examination of the following traditional factors:

- (i) the degree of similarity between the mark or trade name and the famous mark,
- (ii) the degree of inherent or acquired distinctiveness,
- (iii) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark,
- (iv) degree of recognition of the famous mark,
- (v) whether the user of the alleged infringing mark or trade name intended to create an association with the famous mark, and
- (vi) any actual association between the mark or trade name and the famous mark.

Additionally, Opposer has failed to plead specific facts to prove dilution by tarnishment. More specifically, Opposer has failed to plead or provide specific facts to prove that Applicant's mark casts the CHEESE BURGER marks in an unflattering light or harms the reputation of the CHEESE BURGER marks through association with inferior products or services.

Fourth Affirmative Defense (Weak Mark)

Opposer's cited registrations are weak marks. The term "cheese burger", when used as a trademark, is a weak mark frequently adopted and registered by others in a variety of contexts. A search of the TESS database revealed approximately nineteen trademark applications and/or registrations that contain term "cheese burger" as a feature. Additionally, Applicant has found Registration 3137799 and Registration 3137801 for marks containing the term "Cheese Burger in Paradise" and containing palm trees in International Class 025. The registrations 3137799 and 3137801 were registered by Jimmy Buffett and are currently owned by JB Intellectual Property, LLC. This implies that Opposer does not have the exclusive

right to use marks containing the terms "Cheeseburger in Paradise" and that there are limitations to the Opposer's use of registrations '610, '057, and '754.

Moreover, Applicant asserts that Opposer's '610, '057, '754 registrations are limited to the area comprising Hawaii, pursuant to a decree of the US District Court for the Central District of California, Western Division in Civil Action No. CV-98-1730 CM (AIJx

Additionally, search of the TESS database reveals a number of trademark applications and/or registrations containing palm trees. A search of the Tess Database revealed at least 315 trademark applications and/or registrations in International Class 025 that contain a picture of a palm tree or palm trees. The differences between the palm tree in Applicant's mark versus the palm tree displayed in Opposer's mark have been explained in previous sections of Applicant's answer.

**Fifth Affirmative Defense
(Lack of Rejection of Applicant's Mark by Trademark Examiner)**

The United States Patent and Trademark Office (USPTO) did not cite Opposer's claimed registrations, nor any other registration or pending application against Applicant's trademark application. The trademark examiner found no conflicting pending trademark applications and found no conflicting trademark registrations. The trademark examiner would have refused registration, or at a minimum, issued at least an initial rejection, based on Opposer's claimed prior existing registrations, if there was any reason to believe that consumers would be confused as to the source of the respective goods/services of the subject marks.

**Sixth Affirmative Defense
(Unclean Hands)**

Opposer's claims are barred by the doctrine of unclean hands. Applicant is and/or will be a small business owner. Small businesses are having trouble staying afloat in today's turbulent economic times. Opposer has a recent history of devastating small businesses by opposing their marks at the onset if it contains the term "cheese burger" or contains a picture of a palm tree without doing research to determine if the marks truly will be competitive in the same market. In this case, the Opposer has no legitimate justification for opposing Applicant's mark.

**Seventh Affirmative Defense
(Reservation)**

Applicant reserves the right to assert any and all other affirmative defenses which it becomes aware of throughout discovery, testimony, and/or otherwise during the pendency of this matter. Such other affirmative defenses include, but are not limited to, estoppel, collateral estoppel, laches, acquiescence, res judicata, abandonment, fraud, mistake, prior registration, and other defenses which Applicant may become aware of throughout the pendency of this matter.

WHEREFORE, having fully answered, Applicant Ellington Barron, prays for judgment against the Opposer, and requests that the Trademark Trial and Appeal Board dismiss this Notice of Opposition with prejudice and enter judgment for the Applicant.

Dated: July 30th 2012

Respectfully submitted,

Ellington Barron
13002 Weiss Drive
Bowie, MD 20715
Ph: 240-274-7540
Email: ayytone@gmail.com

PROOF OF SERVICE BY MAIL

I, Ellington Barron, the undersigned, hereby declare as follows:

1. I am over 18 years and I am the Applicant/Defendant in Opposition No. 91205697
2. My address is 13002 Weiss Drive, Bowie, MD 20715.
3. On July 30, 2012, at 13002 Weiss Drive, Bowie, MD 20715, I served a true copy of the attached document, entitled "**Applicant's Answer To Notice Of Opposition**" by placing the documents in an addressed, sealed envelope clearly labeled to identify the person being served at the address shown below and placed this in the mail for deposit in the United States Postal Service on that date in accordance with ordinary business practices:

Steven J. Nataupsky
Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

4. An electronic copy was also emailed to efiling@kmob.com.
5. I declare that the foregoing is true and correct. Executed July 30, 2012, at Bowie, MD.


Ellington Barron